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09/942,112	08/28/2001	Thomas Marshall	1136.ACT2.NP	6920

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,112

Applicant(s)

MARSHALL ET AL.

Examiner

Ryan M Flandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Applicant's election of Species I in the reply filed on 9/13/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claim 23 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse. The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. In view of Applicant's amendment to the claims submitted 9/13/04, the Examiner's objections to the claims set forth in the previous Office action (mailed 6/30/04) are hereby withdrawn.

4. Claims 6 and 21 are objected to because of the following informalities:
- a. In Claim 6, line 1, the word --the-- should be inserted after the word "wherein".
 - b. In Claim 21, line 2, the recitation "selecting a ~~joint~~ facing strip having a facing strip..." is nonsensical.
 - c. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. Claims 1-3, 6, 7, 10, 13, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Herms (US 980,255).

- a. Claim 1. Herms shows a joint comprising a first plate 1; a second plate 1; and a facing strip 5 having a first end and a second end with lateral edges 8 extending along the sides therebetween configured for engaging the first and second plates 1, the facing strip 5 being bent so as slope outwardly toward the first and second plates 1 and contact the first and second plates 1 at lateral edges 8 of the facing strip 5 (see figure 1).
- b. Claim 2. Herms further shows the facing strip 5 further comprises at least one bracket 2 attached thereto for receiving a bolt 4 (see figure 1).
- c. Claim 3. Herms further shows the at least one bracket 2 comprises an opening for sliding a bolt 4 into the bracket 2 (see figures 1 and 2).
- d. Claim 6. Herms further shows [the] only portion of the facing strip 5 which touches the first and second plates 1 are the lateral edges 8 extending the length of the facing strip 5 (see figure 1).
- e. Claim 7. Herms shows and discloses a joint strip comprising a facing strip 5 having a bent central portion 7 and walls 8 having lateral edges extending substantially the length of the facing strip 5 and extending away from the bent central portion 7; and at least one bracket 2 attached to the facing strip 5 for engaging a bolt 4 so as to hold the bolt 4 to the facing strip 5 (see figure 1).
- f. Claim 10. Herms shows and discloses a joint strip for attaching a pair of steel plates 1 together, the joint strip comprising a facing strip 5 configured to engage a pair of steel

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plates 1; and at least one bracket 2 attached to the facing strip 5 and having an opening for receiving the head of a bolt 4 and for holding the bolt 4 to the facing strip (see figure 1).

g. Claim 13. Herms shows a joint strip for attaching a pair of steel plates 1 together, the joint strip comprising a facing strip 5 defining a pair of sloped walls 8 extending outwardly and rearwardly from a central portion 7 extending along a long axis of the facing strip 5 and means 2,6 for attaching a bolt 4 to the facing strip 5 (see figure 1).

h. Claim 16. Herms shows a method comprising disposing first and second plates 1 adjacent one another so as to leave an opening; placing a facing strip 5 over the opening generally parallel to the opening so that the facing strip 5 slopes rearwardly and outwardly into engagement with the first and second plates 1 to secure the plates 1 together (see figure 1). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

i. Claim 17. Herms further shows the facing strip 5 has lateral edges 8 extending the length of the facing strip 5 and wherein the only portion of the facing strip 5 which engage[s] the first and second plates 1 is the lateral edges 8 (see figure 1).

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6. Claims 1-3, 7, 13, 16, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 2021170 (hereinafter “the ‘170 patent”).

a. Claim 1. The ‘170 patent shows a joint comprising first plate and second plates **1**; and a facing strip **23** having a first end and a second end with lateral edges extending along the sides therebetween configured for engaging the first and second plates **1**, the facing strip **23** being bent so as slope outwardly toward the first and second plates **1** and contact the first and second plates **1** at lateral edges of the facing strip **23** (see figure 6).

b. Claim 2. The ‘170 patent further shows the facing strip **23** further comprises at least one bracket **20** attached thereto for receiving a bolt **22,24** (see figure 6).

c. Claim 3. The ‘170 patent further shows the at least one bracket **20** comprises an opening **21** for sliding a bolt **22,24** into the bracket **20** (see figures 6 and 7).

d. Claim 7. The ‘170 patent shows a joint strip comprising a facing strip **23** having a bent central portion and walls **23a,b** having lateral edges extending substantially the length of the facing strip **23** and extending away from the bent central portion; and at least one bracket **20** attached to the facing strip **23** for engaging a bolt **22,24** so as to hold the bolt **22,24** to the facing strip **23** (see figures 6 and 7).

e. Claim 13. The ‘170 patent shows a facing strip **23** defining a pair of sloped walls **23a,b** extending outwardly and rearwardly from a central portion extending along a long axis of the facing strip **23** and means **20,21** for attaching a bolt **22,24** to the facing strip **23** (see figures 6 and 7).

f.

g. Claim 16. The '170 patent shows a method comprising disposing first and second plates 1 adjacent one another so as to leave an opening; placing a facing strip 23 over the opening generally parallel to the opening so that the facing strip 23 slopes rearwardly and outwardly into engagement with the first and second plates 1 to secure the plates 1 together (see figure 1). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

h. Claim 20. The '170 patent shows placing first and second plates 1 adjacent one another so as to leave a seam therebetween; selecting a joint strip having a facing strip 23 and a bracket 20 attached to the facing strip 23 for holding an end of a bolt 22,24 to the facing strip 23 independent of the bolt 22,24; and covering the seam between the plates 1 with the facing strip 23 so that the bolt 22,24 extends through the seam (see figures 6 and 7). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

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- i. Claim 21. The '170 patent further shows selecting a [joint] strip having a facing strip **23** which is beveled to have two rearwardly extending walls **23a,b** terminating a lateral edges (see figures 6 and 7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4, 9-11, 14, 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '170 patent, as applied above.

- a. Claim 10. The '170 patent shows a joint strip for attaching a pair of plates **1** together, the joint strip comprising a facing strip **23** configured to engage a pair of plates **1**; and at

least one bracket **20** attached to the facing strip **23** and having an opening **21** for receiving the head of a bolt **22,24** and for holding the bolt **22,24** to the facing strip **23** (see figures 6 and 7). The '170 patent does not disclose or teach the plates **1** being made of steel, but it has been held that the selection of a known material based upon its suitability for the intended use is an obvious variation and a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Replacing the wooden plates **1** shown in the '170 patent would not materially alter the function of the joint defined therein and one of ordinary skill in the art would recognize the advantages of using steel plates such as increased strength.

b. Claims 4, 9 and 11. As set forth above, the '170 patent shows the facing strip **23** having at least one bracket **20** having an opening **21**, but lacks at least two brackets each having an opening for receiving a bolt, and wherein the openings on the at least two brackets are disposed on opposite sides of the brackets from one another. Nevertheless, it has been held that duplicating the components of a prior art device is an obvious variation within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Here, it would have been obvious to one of ordinary skill in the art to add additional brackets where necessary depending on the length of the joint seam. Furthermore, as to the openings positioned on opposite sides of the brackets, it has been held that the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is an obvious variation within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Again, it would have been obvious to one of ordinary skill in the art to adjust the

positioning of the brackets and their respective openings. In any event, the recitation of “the openings on the at least two brackets are *disposed on opposite sides of the brackets from one another*” can be broadly read to simply require openings on the “sides” of the brackets which face towards and away from the plates being connected.

c. Claims 14 and 18. As set forth above, the ‘170 patent shows the means **20,21** for attaching the bolt **22,24** to the facing strip **23** comprises a bracket **20** fixedly attached to the facing strip **23** and configured to receive a bolt **22,24** (see figures 6 and 7). The ‘170 patent lacks disclosure, however, that the means **20,21** is a plurality of brackets.

Nevertheless, it has been held that duplicating the components of a prior art device is an obvious variation within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Here, it would have been obvious to one of ordinary skill in the art to add additional brackets where necessary depending on the length of the joint seam.

d. Claims 15 and 19. As set forth above, the ‘170 patent shows the facing strip **23** having at least one bracket **20** having an opening **21** for receiving a bolt **22,24** (see figures 6 and 7), but lacks disclosure that the openings on the at least two brackets are disposed on opposite sides of the brackets from one another. It has been held, however, that the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is an obvious variation within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Here, it would have been obvious to one of ordinary skill in the art to adjust the positioning of the brackets and their respective openings. In any event, the recitation of “the openings on the at least two brackets are *disposed on opposite sides*

of the brackets from one another” can be broadly read to simply require openings on the “sides” of the brackets which face towards and away from the plates being connected.

The ‘170 patent at least meets this reading of the claim.

10. Claims 5, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Herms or the ‘170 patent, as applied above, in view of Swiss patent 597,451 (hereinafter “the ‘451 patent”).

a. Claims 5 and 8. Herms further shows the facing strip **5** has walls **8** extending rearwardly to the first and second plates **1**. Likewise, the ‘170 patent shows the facing strip **23** has walls **23a,b** extending rearwardly to the first and second plates **1**. Both references, however, fail to disclose that the walls **8** extend at an angle of about 12.5 degrees. The ‘451 patent, however, teaches that a facing strip **2 or 90 or 100** may have walls **6 or 9 or 10** which extend at any number of angles depending on the relative positioning angles of the plates **7** being connected (see figures 2-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the walls **8** of the facing strip of Herms or the ‘170 patent extending at an angle of about 12.5 degrees depending on the relative angle of the plates being connected as taught by the ‘451 patent.

b. Claim 12. Herms shows the facing strip **5** has walls **8** extending rearwardly to the first and second plates **1**. Likewise, the ‘170 patent shows the facing strip **23** has walls **23a,b** extending rearwardly to the first and second plates **1**. Both references, however, fail to disclose that the walls **8** extend at an angle of about 155 degrees from one another.

The '451 patent, however, teaches that a facing strip **2 or 90 or 100** may have walls **6 or 9 or 10** which extend at any number of angles depending on the relative positioning angles of the plates **7** being connected (see figures 2-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the walls **8** of the facing strip of Herms or the '170 patent extending at an angle of about 155 degrees from one another depending on the relative angle of the plates being connected as taught by the '451 patent.

Response to Arguments

11. First, with regard to Applicant's summary of the interview which was conducted on 13 July 2004, the Examiner respectfully disagrees with the characterization that the term bracket was agreed "as including a shelf". As noted in the Interview Summary mailed 20 July 2004, it was agreed a bracket is generally considered an L-shaped member, one leg of which is attached to a vertical surface and the other leg of which supports a shelf *or the like*. It was agreed that Pates did not teach a bracket within this meaning, but this argument is moot in view of the new ground(s) of rejection presented herein. In any event, the aforementioned definition of a "bracket" as requiring an L-shaped member does not even structurally define element 38 as set forth in the instant application. It is noted that the features upon which applicant relies (i.e., L-shape) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Here, such limitations are not even

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present in the specification. As such, the Examiner maintains the right to broadly interpret the term "bracket".

12. Again, Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection presented above.

Allowable Subject Matter

13. Claim 22 is objected to as being dependent upon a rejected base claim and an intervening claim which has been objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims that are corrected to overcome pending objections.

14. The following is a statement of reasons for the indication of allowable subject matter: the prior art, including Herms, the '170 patent, and the '451 patent, either alone or in combination fail to teach or disclose the bracket being attached to the facing strip independent of the bolt *and* the only portion of the facing strip touching the plates being the lateral edges.

Conclusion

15. Despite Applicant's amendments to the claims, this action is **NON-FINAL** based on the new rejections set forth against claims 10-12 which were substantially unamended (except as to formal matters).

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RMF

November 27, 2004



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